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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,718	02/03/2004	G. Michael Roebuck	ROE 002	4137

51713 7590 10/16/2008  
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EXAMINER
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MEYERS, MATTHEW S

ART UNIT	PAPER NUMBER
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3689

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,718	<b>Applicant(s)</b> ROEBUCK, G. MICHAEL	
	<b>Examiner</b> MATTHEW S. MEYERS	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 12 and 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to applicant's communication on 2/3/04, wherein claims 1-21 are currently pending.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### ***Claim Objections***

3. Claims 12 and 12 have been objected to because of the following informalities: applicant has misnumbered claims and included two claims, each designated 12. Examiner has continued the numbering and renumbered the second 12 with a 13. Therefore applicant's application contains claims 1-21, rather than 1-20.
4. Claims 19-21 have been objected to because of the following informalities: Each claim must begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Additionally, where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's "performing a query session" step is unclear as to what it entails. Does it require a back and forth dialog, does the query session occur with another human? Is this person an inventor?

7. Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what is being filed in the third method step? Is this a complete specification? What happens to the information after the third method step?

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-19 are rejected under 35 U.S.C. 101 because In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184

Art Unit: 3689

(1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-19, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-5 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Grainger (Pub. No.: US 2002/0161733).

12. With respect to **Claim 1**:

13. Grainger discloses a method for drafting a patent application, comprising:

- a. performing a first query session with an inventor to define elements of a first subject matter (Grainger Fig 3C and 3D); and

Art Unit: 3689

- b. generating a first patent specification based on the first subject matter defined elements (Grainger [0121], "...system 100 checks to ensure that the application includes a complete Specification.")

14. With respect to **Claim 2**:

15. Grainger discloses filing a patent application based on the first patent specification (Grainger [abs], "causing the patent application to be filed in a patent office.").

16. With respect to **Claim 3**:

17. Grainger discloses drawing a first figure based on the first subject matter defined elements (Grainger Fig 3J).

18. With respect to **Claim 4**:

19. Grainger discloses conducting a second query session with an inventor to define elements of a second subject matter; drafting a second patent specification based on the second subject matter defined elements; and combining the first and second patent specifications (Grainger Fig 3C and 3D and [0121], "...system 100 checks to ensure that the application includes a complete Specification.").

20. With respect to **Claim 5**:

21. Grainger discloses drawing a second figure based on the second subject matter defined elements (Grainger Fig 3J).

22. With respect to **Claim 11**:

23. Grainger discloses generating a process flow chart (Grainger Fig 3J).

24. With respect to **Claim 12**:

Art Unit: 3689

25. Grainger discloses generating an apparatus figure (Grainger Fig 3J).
26. With respect to **Claim 13:**
27. Grainger discloses wherein the subject matter comprises a process (Grainger Fig 3A).
28. With respect to **Claim 14:**
29. Grainger discloses wherein the subject matter comprises an apparatus (Grainger Fig 3A).
30. With respect to **Claim 15:**
31. Grainger discloses conducting a query session to generate an assignment for filing with the patent application (Grainger [0057]).
32. With respect to **Claim 16:**
33. Grainger discloses conducting a query session to generate an assignment for filing with the combined patent application (Grainger [0057]).
34. With respect to **Claim 17:**
35. Grainger discloses receiving an assignment to a common entity from the inventor for filing with a patent application (Grainger [0057]).
36. With respect to **Claim 18:**
37. Grainger discloses receiving an assignment to a common entity from the second inventor for filing with a patent application (Grainger [0057]).

Art Unit: 3689

***Claim Rejections - 35 USC § 103***

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

40. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger as applied to claims 1-5 and 11-21 above and further in view of MPEP Eighth edition, Chapter 600, August 2001 (Hereinafter referred to as MPEP).

41. With respect to **Claims 6-10**:

42. Grainger discloses all the above limitations including drawings in the application (Grainger Fig 3J), but does not explicitly disclose adjusting reference numerals in the first and second figure or specification and the first and second figure or specification so that each figure or specification has unique reference numerals associated with elements shown in the figures or specification. MPEP discloses the formalities that must be complied with when filing a patent application in order to meet the statutory requirements set forth (MPEP 608.02). Therefore, it would have been obvious to one of



Art Unit: 3689

ordinary skill in the art at the time of the invention to have incorporated the MPEP into the Method of creating electronic prosecution experience for patent applicant of Grainger in order to ensure compliance with the rules and regulations of the patent office, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

43. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger in view of MPEP.

44. With respect to **Claims 19-21**:

45. Grainger discloses a method, apparatus and computer readable medium containing instructions that when executed by a computer perform the steps of drafting a patent application: performing a first query session with an inventor to define elements of a first subject matter (Grainger Fig 3C and 3D); generating a first patent specification based on the first subject matter defined elements (Grainger [0121], "...system 100 checks to ensure that the application includes a complete Specification."). drawing a first figure based on the first subject matter defined elements (Grainger Fig 3J). conducting a second query session with an inventor to define elements of a second subject matter; drafting a second patent specification based on the second subject matter defined elements; combining the first and second patent specifications (Grainger Fig 3C and 3D and [0121], "...system 100 checks to ensure that the application includes a complete Specification."); drawing a second figure based on the second subject matter defined elements (Grainger Fig 3J); generating a process flow chart (Grainger Fig 3J); generating an apparatus figure (Grainger Fig 3J); receiving an assignment to a

Art Unit: 3689

common entity from the inventor for filing with a patent application (Grainger Fig 3A and [0057]); and receiving an assignment to a common entity from the second inventor for filing with a patent application (Grainger Fig 3A and [0057]).

46. Grainger discloses all the above limitations including drawings in the application (Grainger Fig 3J), but does not explicitly disclose adjusting reference numerals in the first and second figure or specification and the first and second figure or specification so that each figure or specification has unique reference numerals associated with elements shown in the figures or specification. MPEP discloses the formalities that must be complied with when filing a patent application in order to meet the statutory requirements set forth (MPEP 608.02). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the MPEP into the Method of creating electronic prosecution experience for patent applicant of Grainger in order to ensure compliance with the rules and regulations of the patent office, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Art Unit: 3689

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Meyers/  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689